

## **REMARKS**

Claims 1-36 are pending in the present Application, with claims 12-36 withdrawn as directed to nonelected subject matter. Claim 1 is amended, claims 2-4, and withdrawn claims 12-23 and 33-36 are cancelled, leaving claims 1 and 5-11 for consideration upon entry of the present Amendment.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

### **Claim amendments**

No new matter is introduced by this amendment. Support for the amendments to claim 1 is found in claims 1-4 as originally filed.

Amendments to and cancellation of claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

### **Allowable Subject Matter**

Applicant notes that the Examiner indicated that claims 2-4 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In order to streamline prosecution and obtain speedy allowance, Applicant has amended claim 1 to be directed to the allowable subject matter of claims 2-4.

### **Claim Objections**

Claims 1-11 were objected to for containing embodiments directed to non-elected inventions.

Claim 1 is amended herein to delete references to nonelected subject matter. Claims 2-4 are cancelled.

Applicants request withdrawal of the objection to claims 1 and 5-11.

### **Claim Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 1 and 5-11 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

As claim 1 is amended to be directed to the subject matter of claims 2-4, the Examiner's argument is moot with respect to amended claim 1. Applicants note their disagreement with the arguments that certain elements of the previously presented version of claim 1 allegedly failed to comply with the written description requirements.

Applicants request withdrawal of the rejection of claims 1 and 5-11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

### **Claim Rejections Under 35 U.S.C. § 102(e)**

Claims 1 and 5-8 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by Venter et al. (WO 02/068579)(hereinafter "Venter"). Applicants respectfully traverse this rejection.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Claim 1 is amended herein to be directed to an isolated nucleic acid molecule selected from the group consisting of: (a) an isolated nucleic acid molecule comprising nucleotides 390-4880 of SEQ ID NO: 1; nucleotides 390-4883 of SEQ ID NO: 1; nucleotides 12-4904 of SEQ ID NO: 3; or nucleotides 12-4907 of SEQ ID NO: 3; and (b) an isolated nucleic acid molecule comprising the complement of the nucleic acid molecule of (a).

Venter is generally directed to the sequencing and assembly of the human genome. (Abstract) However, Venter does not disclose the claimed isolated nucleic acid molecule recited in claim 1.

As all elements of claim 1 are not taught by Venter, Venter cannot anticipate claim 1. Applicants request withdrawal of the rejection of claims 1 and 5-11 as anticipated by Venter

**Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 1, 6, and 8-12 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Venter in view of Kuo et al (EP 0150735) (hereinafter “Kuo”). Applicants respectfully traverse this rejection.

Applicants note that claim 12 is directed to nonelected subject matter and assume this was a typographic error.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

Amended claim 1 is directed to an isolated nucleic acid molecule selected from the group consisting of: (a) an isolated nucleic acid molecule comprising nucleotides 390-4880 of SEQ ID NO: 1; nucleotides 390-4883 of SEQ ID NO: 1; nucleotides 12-4904 of SEQ ID NO: 3; or nucleotides 12-4907 of SEQ ID NO: 3; and (b) an isolated nucleic acid molecule comprising the complement of the nucleic acid molecule of (a). Claims 6 and 8-11 depend directly or indirectly from claim 1.

As discussed above, Venter fails to teach each and every element of claim 1. Therefore Kuo must make up for these deficiencies of Venter.

Kuo is generally directed to methods and compositions for preparation of Factor VIIIC. (Abstract) However, Applicants can find no place in Kuo teaching the isolated nucleic acid molecule recited in claim 1.

As Venter and Kuo, taken alone or in combination, fail to teach or suggest all elements of independent claim 1, claim 1 and dependent claims 6 and 8-11 cannot be obvious over the combination.

Applicants request withdrawal of the rejection of claims 6 and 8-11 as obvious over Venter in view of Kuo.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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